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10/611,775

06/30/2003

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EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

06/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/611,775 | Applicant(s) HILL, JOHN C. | |
| | Examiner Isis A. Ghali | Art Unit 1611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/25/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicant's amendment filed 02/25/2008; request to correct inventorship pursuant to 37 C.F.R. § 1.48 filed 04/29/2008, and petition to correct claim of priority pursuant to 37 C.F.R. § 1.78(a)(3) filed 04/29/2008.

Claims 1-22 have been canceled. Claims 23-40 are pending

Claims 23-34 have been previously withdrawn from consideration as being directed to non-elected invention.

Claims 35-40 are included in the prosecution.

Priority - 37 C.F.R. § 1.78(a)(3)

1. Petition to claim priority pursuant to 37 C.F.R. § 1.78(a)(3) is waiting for decision. Applicant will be notified in due course.

Inventorship

2. In view of the papers filed April 29, 2008, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been

Art Unit: 1611

corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding the following three inventors: James H. Brown, Sambasivarao Koritala, and Robert Kleiman.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Election/Restrictions

3. This application contains claims 23-34 drawn to an invention nonelected with traverse in the reply filed on 07/16/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The following rejection has been overcome by virtue of applicants' amendment and remarks:

The rejection of claims 35-40 under 35 U.S.C. 112, second paragraph, as being indefinite.

The following rejection has been discussed in the previous office action, and is maintained for reasons of record:

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,649,177 ('177).

The present claims are directed to method of providing a benefit to a topical composition by adding hydrolyzes jojoba oil to acid gelling agent.

US '177 disclosed hydrolyzed jojoba oil added to cosmetic compositions to enhance their desirable properties and used to good effect in a varieties of cosmetic formulations (abstract; col.2, lines 52-58). The reference disclosed that the jojoba oil is added to the cosmetic formulation during preparation (col.2, lines 65-67), which reads on the step of the claimed method. Example 4, tables 2, 7, 8, and 12 of the reference disclosed topical cosmetic formulation comprising jojoba protein and wheat germ oil, which meets the limitations of materials claimed by claims 36 and 39. The reference disclosed hydrolyzing the jojoba oil by alkali (example 1). Applicants disclosed in page 14, first and second paragraphs that:

“The composition of materials created by the method according to the present invention are produced by the reaction of aqueous alkali metal hydroxides, e.g., NaOH, LiOH, KOH (the preferred hydroxide), CaOH, MgOH, and the like, with organic lipid

Art Unit: 1611

compositions, usually plant extracts, oils, fats, or waxes (of the extracts or derivatives Of the extracts) where the organic compositions contain a high proportion of unsaponifiable materials (greater than 6%), and preferably as long chain esters.

Jojoba oil may be examined as an example case. Refined jojoba oil contains various proportions of long chain diunsaturated esters. Hydrolysates of refined jojoba oil are nearly a 55:45 mixture of polar hydrophilic long chain salts (alkali salts) and relatively non-polar lipophilic materials (fatty alcohols). The lipophilic fraction is the unsaponifiable materials according to the definition used in this document. The carbon chain lengths of both of these jojoba Hydrolysates include and vary from C18 to C24 and have co-9 double bonds as part of each molecule. It has been found that the combination of saponifiable and unsaponifiable fractions of the Hydrolysates according to the present invention has properties that aid in the formulation of cosmetic, pharmaceutical, and other compositions."

Therefore, the reference disclosed the same method as applicant's method of obtaining the claimed composition that comprises polar hydrophilic salts and non-polar unsaponifiable materials. Hence, since the reference disclosed hydrolyzed jojoba oil produced by same method as applicant's method, then the composition produced by the reference will inherently have the same hydrolysis product. Jojoba oil inherently has the same amount of unsaponifiable materials prior to hydrolysis. The neutralization of acidic gelling agent is inherent.

US '177 disclosed adding the jojoba oil product to cosmetic composition including gels (col.3, lines 4-20). The reference disclosed gel comprising carbomer (col.16, line 38 till col.17, line 18). Applicant disclosed carbomer as one of the acidic gelling agent in page 15 last paragraph.

The limitations of claims 35-40 are met by US '177.

Response to Arguments

6. Applicant's arguments filed 02/25/2008 have been fully considered but they are not persuasive.

Applicant traverses this rejection by arguing that the Examiner failed to examine each and every element of the applicant's claimed subject matter, because the examiner compares the reference to applicant's specification to support the conclusion that "the reference disclosed the same method as applicant's method of obtaining a claimed composition that comprises polar hydrophilic salts and non-polar unsaponifiabiles." It is incorrect to examine Applicant's specification in a § 102 rejection to determine "claimed subject matter", wherein the Examiner is limited to each and every limitation of the actual claimed subject matter.

In response to this argument, it is argued that the examiner relied on the specification only for interpretation of claims' limitations and that is permissible. The examiner used the specification to interpret the "polar hydrophilic salts and non-polar unsaponifiabiles, wherein said polar hydrophilic salts comprise the products of hydrolysis of a saponifiable fraction of original material comprises more than about 10 weight percent long carbon chain material prior to hydrolysis". In order to understand such limitation, the examiner referred to the specification to find the scope of the limitation. The specification described how to make such salts, therefore the salts are defined by their way of production, and the references produced salts of jojoba oils by the same way as the present invention using the same starting materials, therefore inherently the

Art Unit: 1611

produced salts have the same functions and properties. It has been held *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969) that in making rejections under the 35 U.S.C. 102 rejection, it was proper to refer to specification and it was explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” Hence, the examiner did not examine Applicant's specification in a § 102 rejection to determine "claimed subject matter", however, interpreted the scope of the claims by referring to the specification as permitted by the USPTO practice.

Applicant argues that the Examiner's rejection does the Examiner address each and every limitation of claim 35, as amended.

In response to this argument, applicant's attention is directed to the scope of the present claims that are directed to method of providing a composition, and the only step method recited by the claims is “adding” material comprising jojoba oil to acid gelling agent. The step of the claimed method is disclosed by the reference at col.2, lines 65-67, as well as the starting elements, as set forth.

Applicants argues that the reference teaches away from the claimed invention by stating that "the preferred hydrolyzed jojoba protein is in the form of an aqueous dispersion containing a mixture of amino acids, peptides and/or protein fractions derived from the hydrolysis of naturally occurring jojoba protein", followed by the removal of "mixtures of amino acids, peptides and/or protein fractions" and subsequent treatments and addition of these mixtures to an aqueous dispersion.

In response to this argument, it is argued that the present claims' language does not exclude amino acids, nor aqueous dispersion. Additionally, the present claims recite hydrolyzed jojoba proteins by reciting "organic material comprising jojoba oil, wherein said original organic material comprises at least more than about 10 weight percent long carbon chain material prior to hydrolysis." Therefore the recited organic material, i.e. jojoba oil, is hydrolyzed.

Applicant argues that the reference teaches removal of insolubles of jojoba protein after hydrolysis. See col. 4, lines 50-55. This is different from the present invention method for providing a "composition comprising polar hydrophilic salts and non-polar unsaponifiables, wherein said polar hydrophilic salts comprise the products of hydrolysis of a saponifiable fraction of original organic material."

In response to this argument, it is argued that the claims' language does not exclude removal of insolubles. Additionally, the reference disclosed removal of insolubles of specific molecular weight, as evident by the reference disclosure that

Art Unit: 1611

filtrate was fed to nanofiltration membrane to retain specific profile of different molecular weights (col.4, lines 56-60), hence, not all insolubles are removed. Therefore, since the reference disclosed hydrolyzed jojoba oil produced by same method as applicant's method, then the composition produced by the reference will inherently have the same hydrolysis product including salt.

Applicant argues that the reference does not disclose use of polar hydrophilic salts and non-saponifiables as products of a hydrolysis of an organic starting material, to increase substantivity and neutralize a gelling agent.

In response this argument, as set forth in this office action, the product of the present invention is produced by the same method of the reference using the same starting material, and inherently the same product is produced. Jojoba oil inherently has the same amount of unsaponifiable materials prior to hydrolysis. The product will inherently increase substantivity and neutralize acidic gelling agents because product and their properties are not separable. Additionally, the present claims are directed to method of providing composition including one step of adding ingredients, and step and the ingredients are disclosed by the reference. The reference disclosed hydrolyzing the jojoba oil by alkali (example 1), and this is the method used by applicants to hydrolyze jojoba oil as per disclosure in page 14.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

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